



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Nalin Mistry et al. § Art Unit: 2619
Serial No.: 10/645,489 §
Filed: August 22, 2003 § Examiner: Man U. Phan
For: Multi-Staged Services Policing § Atty. Dkt. No.: NRT.0180US
§ (15791ROUS02U)

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

REJECTION UNDER 35 U.S.C. § 103

In Applicant's Reply to Office Action submitted on August 22, 2007, Applicant pointed out that the previous Office Action did not discuss how a key element of claim 1 was disclosed or hinted at by Buskirk and Bonaventure. Specifically, claim 1 recites an upstream services policer to receive feedback from the downstream services policer. The present Office Action merely copied the § 103 rejection of claim 1 verbatim from the previous Office Action, and added a Response to Arguments section on pages 2-5, and still fails to address how the above specific element of claim 1 was taught or hinted at by the cited references. The Response to Arguments section of the Office Action cited case law regarding establishing a "*prima facie*" case, cited case law regarding the test for combining references, and cited case law for the proposition that claim terms are to be given their "broadest reasonable interpretations while

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determining patentability of the disclosed invention.” None of these adequately addresses the failure of the references to teach or hint at an upstream services policer to receive feedback from the downstream services policer, as recited in claim 1. Giving a broad, reasonable interpretation of a claim term, does not allow the Examiner to **ignore** an express claim element.

There is absolutely no hint anywhere in the hypothetical combination of Buskirk and Bonaventure of an upstream services policer as recited in claim 1 that is able to receive feedback from the downstream services policer. As depicted in Fig. 4 of Buskirk (also cited by the Office Action), components of an ingress processing system include a policer 404 as well as a classifier 402 and an editor 406. There is **only one** policer; there is no teaching in Buskirk of multiple policers, as recited in claim 1, which was conceded by the Office Action. *See* 12/29/2007 Office Action at 8. Thus, it would be impossible for Buskirk to have an upstream services policer that transmits a traffic unit to a downstream services policer, and that **also receives feedback** from the downstream services policer.

Bonaventure does not remedy the defect in Buskirk regarding teaching the elements of claim 1. Bonaventure discloses a first determiner DET1 that determines a lower order identifier of a received packet, and a second determined DET2 that determines a higher order identifier of the received packet. Bonaventure also discloses two controllers, CTRL1 and CTRL2, that execute a lower order conformance checking and a higher order conformance checking, respectively. However, there is absolutely no indication of the lower order conformance controller CTRL1 transmitting a traffic unit to the higher order conformance controller CTRL2, in combination with the lower order conformance controller CTRL1 receiving **feedback** from the higher order conformance controller CTRL2.

Since the hypothetical combination of the references does not disclose or hint at all elements of claim 1, the obviousness is defective for at least this reason.

As held by the Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459 (1965), factual inquiries to be performed in an obviousness analysis include determining the scope and content of the prior art, and ascertaining the differences between the prior art and the claims at issue. *Id.* at 17. The above has set forth the scope and content of the cited references Buskirk and Bonaventure, and how the teachings of these references (when hypothetically combined) would have led to subject matter significantly different from the claimed subject matter.

Moreover, no reason existed that would have prompted a person of ordinary skill in the art to combine the teachings of the references. *See KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741, 82 U.S.P.Q.2d 1385 (2007). In the Background section of Buskirk, Buskirk criticized the use of “multiple specialized circuits [that] are required to accommodate packets of each packet protocol that might traverse the network switch, router, bridge, or other intermediate system between the source and destination.” Buskirk, 3:34-41. Instead, Buskirk proposed “a method and apparatus for commonly policing packets of multiple transmission protocols.” Buskirk, 3:42-44. As depicted in Fig. 4 of Buskirk, a single policer is used to implement policing for multiple flows of multiple protocols. As taught by Buskirk, its arrangement is a “tightly coupled arrangement facilitated by the integration into a common chip.” Buskirk, 9:42-47. The policing engine of Buskirk multiplexes multiple flows into a single stream, and applies policing on that single stream. Buskirk, 9:59-66.

In other words, rather than provide a hint or suggestion of the claimed subject matter, Buskirk actually would have led a person of ordinary skill in the art **away** from the claimed invention by teaching that it would be more desirable to integrate policing functions into a single policer. In view of the foregoing, a person of ordinary skill in the art would clearly not have been prompted to combine the teachings of Buskirk and Bonaventure to achieve the claimed subject matter. The above is a further reason that the obviousness rejection of claim 1 over Buskirk and Bonaventure is defective.

Independent claim 10 is allowable for similar reasons as claim 1. Moreover, claim 10 recites that feedback received from the downstream services policer is to cause the upstream services policer to *modify* analysis by the upstream services policer of further received traffic units. There is absolutely no hint provided anywhere in Buskirk and Bonaventure of this additional feature of claim 10.

Independent claim 12 is allowable over the cited references for similar reasons as claim 10.

Amended independent claim 13 is also non-obvious over Buskirk and Bonaventure, since the asserted combination of the references do not disclose or hint at a second upstream services policer that analyzes a traffic unit according to a *second class* of service and that amends the traffic unit to indicate that the traffic unit is a traffic unit for a *first class* of service *rather than the second class of service*.

In the previous Reply to Office Action submitted on August 22, 2007, independent claim 14 was amended to recite subject matter corresponding to subject matter considered by the Office Action to be allowable in claim 9. However, the present Office Action failed to respond to this amendment made in claim 14, and merely repeated the same obviousness rejection against claim 14 raised in the previous Office Action. Such a rejection is clearly improper, as it fails to address subject matter added to a claim.

In view of the foregoing, withdrawal of the obviousness rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. § 112, ¶ 1

Claims 15-21 were rejected under § 112, ¶ 1 as allegedly failing to comply with the written description requirement. Applicant respectfully disagrees with this rejection.

The subject matter of claims 15, 19, and 21 is supported by at least the following passages of the Specification: 6:23-28; 7:26-8:2.

With respect to claim 16, Fig. 2 of the Specification shows multiple upstream services policers (*e.g.*, 202, 204, 208, 210), and a downstream services policer (*e.g.*, 206, 212). Moreover, the Specification on page 10, at lines 7-19, refers to feedback.

With respect to claim 17, Fig. 2 shows multiple upstream services policers (*e.g.*, 202, 204, 208, 210), and multiple downstream policers (*e.g.*, 206, 212). A description of various policers of Fig. 2 is found at least on pages 8-10 of the Specification.

With respect to claim 18, Fig. 2 of the Specification shows multiple upstream services policers and downstream services policers, as noted above. With respect to claim 20, Fig. 2 shows an output trunk policer 212 (an example of a downstream services policer) that affords higher priority to traffic units received from the AF COS policer 208 than from a best effort COS policer 210.

In view of the foregoing, it is respectfully submitted that newly added claims 15-21 are adequately supported by the written description.

CLAIM OBJECTION

The Office Action objected to use of the term “adapted to” in various claims. Applicant respectfully traverses this objection.

Contrary to the assertion in the Office Action, courts have approved the use of “adapted to” as providing structural limitations. *See In re Venezia*, 189 U.S.P.Q. 149, 151-152 (C.C.P.A. 1976) (“Rather than being a mere direction of activities to take place in the future, this language [“adapted to”] imparts a structural limitation”). The court in *In re Venezia* stated that there is “nothing wrong in defining the structures of the components ... in terms of the interrelationship of the components.” *Id.* at 152. The case cited in the Office Action, *In re Hutchinson*, 69 U.S.P.Q. 138 (C.C.P.A. 1946), involved use of “adapted” in defining a field of use. The clause at issue in *In re Hutchinson* is “an article of manufacture, adapted for use in the fabrication of a metal template or the like,” which was provided in the preamble of the claim at issue to define a field of use of the claimed article. In contrast, the claims of the present application recite “adapted to” to define the interrelationship between components of the claimed invention, which has been held by cases as imparting structural limitation.

In view of the foregoing, withdrawal of the objection is respectfully requested.

CONCLUSION

The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 20-1504 (NRT.0180US).

Respectfully submitted,

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